

Amendment and Response

Applicant: Andrew W. Barr et al.

Serial No.: 10/714,386

Filed: Nov. 14, 2003

Docket No.: 200308581-1/H300.217.101

Title: SYSTEM AND METHOD FOR TESTING A MEMORY WITH AN EXPANSION CARD USING DMA

REMARKS

The following remarks are made in response to the Office Action mailed March 5, 2007. Claims 9-14 were rejected. Claims 1-8 and 15-20 have been allowed. Claims 9 and 10 have been amended. Claims 1-20 remain pending in the application and are presented for reconsideration and allowance.

Examiner Interview Summary Pursuant to 37 CFR §1.133(b)

Applicants appreciate the interview with Examiner Aditya Bhat on May 11, 2007. In the interview, Applicants discussed the rejection of claims 9-14 under 35 U.S.C. § 101 with the Examiner.

No agreement was reached between Applicant and the Examiner on any issues regarding the outstanding claims.

Claim Rejections under 35 U.S.C. § 101

Claims 9-14 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Office Action has failed to set forth a *prima facie* case that claims 9-14 are directed to non-statutory subject matter. The Office Action does not allege that claims 9-14 are not within one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. §101 (i.e., a process, a machine, a manufacture or a composition of material). See MPEP § 2106 (IV)(B). In addition, the Office Action does not identify a judicial exception to 35 U.S.C. §101 (e.g., abstract ideas such as mathematical algorithms, natural phenomena, or laws of nature) to which the Office Action believes claims 9-14 are directed. See MPEP § 2106 (IV)(C).

“The examiner bears the initial burden ... of presenting a *prima facie* case of unpatentability.” In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444, (Fed. Cir. 1992) (cited in MPEP § 2106 (IV)(D)). To establish a *prima facie* case that claims 9-14 are directed to non-statutory subject matter based on a judicial exception to 35 U.S.C. §101, the Office Action must identify and explain in the record the reasons why a claim is for an abstract idea with no practical application. See MPEP § 2106 (IV)(D). The

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present Office Action only alleges that claims 9-14 “are directed to a judicial exception”, Office Action, p. 2, and does not identify an abstract idea embodied by claims 9-14.

Even assuming *arguendo* that the Office Action can identify an abstract idea embodied by claims 9-14, the Office Action must show that claims 9-14 do not provide a transformation or reduction of an article to a different state or thing and do not produce a useful, tangible, and concrete result to demonstrate that claims 9-14 have no practical application. See MPEP §§ 2106 (IV)(C)(1) and 2106 (IV)(C)(2).

Claim 9 recites “providing the test transaction to the portion using direct memory access (DMA) to cause information to be read from or stored into the portion” Applicants respectfully submit that these features of claim 9 clearly transform “the portion” into a different state by causing “information to be read from or stored into the portion” and therefore claim 9 has a practical application. Accordingly, claim 9 and claims 10-14 which depend from claim 9 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this reason.

In addition, these features of claim 9 produce a useful, tangible, and concrete result. Namely, “providing the test transaction to the portion using direct memory access (DMA) to cause information to be read from or stored into the portion” produces a useful, tangible, and concrete result associated with “the portion”. Accordingly, claim 9 and claims 10-14 which depend from claim 9 have a practical application and do not fall within a judicial exception to 35 U.S.C. §101 for at least this additional reason.

Further, claim 10 has been amended to recite “performing a remedial action associated with the portion in response to detecting the error.” Applicants respectfully submit that this feature of claim 10 both provides a state transformation and produces a useful, tangible, and concrete result by “performing a remedial action”. Accordingly, claim 10 does not fall within a judicial exception to 35 U.S.C. §101 for at least this additional reason.

As described above, the Office Action has failed to set forth a *prima facie* case that claims 9-14 are directed to non-statutory subject matter. Accordingly, Applicants respectfully request withdrawal of rejection of claims 9-14 under 35 U.S.C. §101.

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Allowable Claims

Claims 1-8 and 16-20 are allowed.

Applicants appreciate the Examiner's consideration and allowance of these claims.

CONCLUSION

In view of the above, Applicants respectfully submit that pending claims 1-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-20 is respectfully requested.

The Examiner is invited to contact the Applicants' representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either David A. Plettner at Telephone No. (408) 447-3013, Facsimile No. (408) 447-0854 or Christopher P. Kosh at Telephone No. (512) 231-0533, Facsimile No. (512) 231-0540. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

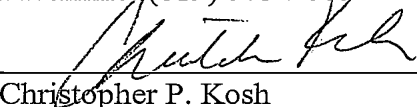
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